

R E M A R K S

Claims 1, 2, 4, and 5 are pending in the present application after this amendment adds new claim 5. Claims 1 and 2 are amended herein. The amendments and new claims do not add new matter and find support throughout the specification and claims, and at least in original claims 1, 2, and 4. In view of the amendments and following remarks, reconsideration and allowance of the present application is respectfully requested.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent No. 5,509,070 to Schull (hereinafter referred to as Schull). Applicants respectfully traverse.

Claim 1 relates to a recording medium readable by an information processor, having at least digital sound data and a program for controlling the reproduction of the digital sound data separately recorded therein. In the recording medium of amended claim 1, the digital sound data is encrypted, and *a decrypting method and key information for decrypting the encrypted digital sound data are recorded in the program for controlling the reproduction of the digital sound data.*

The Examiner asserts that Schull discloses the decrypting method and key information for decrypting the encrypted digital sound data being recorded in a program at column 14, lines 48-50 and 57-59. (Office Action; page 2, lines 5-7). However, the cited section of Schull apparently discusses a Programmer's Program accessing decrypted data and containing a key for decryption. The cited sections of Schull state, in their entirety, "the Programmer's Program could serve decrypt data stored in separate files on the CD-ROM" (Schull; col. 14, lines 48-50), and "[o]ne way that this could be accomplished would be for the Programmer's program to contain the key needed to decrypt the encrypted data and to invoke that key only in the presence of an

appropriate password." (Schull; col. 14, lines 57-59). However, a program that *accesses* decrypted data and contains a key for decryption does not disclose or suggest a *decrypting method and key information being recorded in a single program*, as recited in unamended claim 1.

However, in the interest of clarifying the claimed invention and expediting prosecution, claim 1 has been amended to recite that a decrypting method and key information for decrypting the encrypted digital sound data are recorded in *the program for controlling the reproduction of the digital sound data*. Therefore, it is now readily apparent that the program that records the decrypted method and the key for decryption is the same program that controls the reproduction of the digital sound data. It is respectfully submitted that Schull does not disclose or suggest such a feature, and therefore for at least this reason claim 1 is allowable.

Claim 2 includes a similar feature to that discussed above in regard to claim 1, and therefore claim 2 is allowable for at least the same reasons as claim 1 is allowable.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schull in view of United States Patent No. 6,141,681 to Kyle (hereinafter referred to as Kyle). Applicants respectfully traverse.

The Examiner asserts that Schull discloses the decrypting method being stored with digital data by the "Programmer's Program" discussed at column 14, lines 46-50. However, the Examiner admits that Schull does not disclose the use of multiple decryption methods stored with the encrypted digital sound data. The Examiner asserts that Kyle discloses this feature, and asserts that the motivation to combine the references is that "a single encryption/decryption method allows hackers to hijack just one key in order to access [a] plurality of data files where employing a multiple encryption/decryption methods makes difficult for hackers to gain access

to plurality of data." (Office Action; page 3, lines 7-8). This motivation to combine appears to be merely a restatement of an advantage claimed by Kyle, but does not provide any motivation to combine Kyle with Schull.

The Federal Circuit addressed the standard for obviousness and the requirement of motivation in *Teleflex, Inc. et al. v. KSR Int'l Co.*, (119 Fed. Appx. 282; 2005 U.S. App. LEXIS 176). The patent at issue in *Teleflex*, related to an electronic pedal position control and a pedal assembly. In *Teleflex*, the district court granted a motion for summary judgment based on invalidity due to obviousness. The Federal Circuit vacated the decision and remanded to the lower court for further proceedings on the issue of obviousness. The Federal Circuit stated that, in regard to obviousness, "a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but some motivation to combine the prior art teachings in the particular manner claimed." (*Teleflex*, citing *In re Koizab*; emphasis added). The Federal Circuit found that there was no motivation to combine the Asano patent, which disclosed all of the limitations except the electronic control, and the Rixon patent, which disclosed an electronic control and an adjustable pedal assembly. As the court further stated:

[t]he district court correctly noted that the nature of the problem to be solved may, under appropriate circumstances, provide a suggestion or motivation to combine prior art references. However, the test requires that the nature of the problem to be solved be such that it would have led a person of ordinary skill in the art to combine the prior art teachings in the particular manner claimed.

(*Teleflex*, citing as background *Rouffet*, 149 F.3d at 1357; emphasis added).

It is respectfully submitted that the present rejection is similar to the rejection discussed in *Teleflex* in that there is no motivation provided in Kyle to combine its teaching with Schull. As the *Teleflex* court held, there must be *specific teaching* to motivate a person of ordinary skill

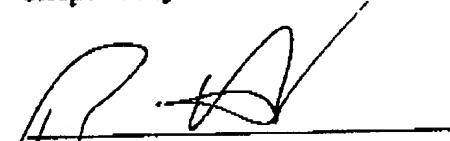
in the art must to combine the prior art teachings *in the particular manner claimed*. Therefore, since there is no motivation to combine the references, the rejection is improper.

New claim 5 depends from claim 1 and is allowable at least for the same reasons as claim 1 is allowable. Additionally, claim 5 recites a feature similar to that recited in claim 4, and therefore is allowable also for at least the same reasons as claim 4 is allowable.

In view of the remarks set forth above, this application is in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,



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